

REMARKS

Claims allowed but for objections

The applicants appreciate the examiner's acknowledgement that claims 13-18 would be allowable if rewritten in independent form.

35 U.S.C. 103(a) rejection

Claims 1-12 remain rejected over Chiu (U.S. Patent 5,095,068) in view of Berejka (U.S. Patent 4,332,655).

In the previous rejection, the examiner requested that "...if the applicants disagree with the statement that amounts taught by Chiu at least overlap those taught by applicant when using the same method of measurement applicants need to demonstrate that this is untrue." The applicants' respectfully request reconsideration of this rejection as the applicants' are still unclear as to the standard upon which the examiner bases the rejection of the claims.

The applicants do not dispute that it is possible that one of the ranges described in Chiu may overlap that of the applicants' claimed invention. However, the claimed invention does read upon a series of isolated ranges but a collection of ranges which must simultaneously be present (with the exception of the "optionally from 1 to 100 parts by mass of accelerator substances." - see claim 1 below:

1. Hot-melt pressure-sensitive adhesive based one or more non-thermoplastic elastomers, comprising
 - at least 100 parts by mass of one or more non-thermoplastic elastomers,
 - from 1 to 100 parts by mass of one or more tackifying resins,
 - from 1 to 100 parts by mass of one or more reactive phenolic resins, for the chemical/thermal crosslinking of the hot-melt pressure-sensitive adhesive, whose methylol content is from 1 to 20% by weight based on the reactive phenolic resin, and
 - optionally from 1 to 100 parts by mass of accelerator substances.

As Berejka was stated to be used by the examiner to show phenolic tackifiers with the claimed methylol content, the remaining ranges must be taught or suggested by the Chiu reference. However, it has never been conclusively shown that Chiu does teach these ranges or that these ranges were contemplated in combination with each other, only suppositions that Chiu may teach these ranges.

As stated previously the ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion *based on underlying findings of fact*.¹ At this point there is merely the presumption that there is overlap of all of the ranges but no factual support for the presumption. It appears to be acknowledged by the examiner that there is no explicit teaching of the collection of ranges which make up the applicants' invention. However, the scope of possible permutations of Chiu's invention is virtually infinite especially if one were to presume other modifications to Chiu's invention would be

¹ see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

obvious and there is no teaching or suggestion within Chiu to select or modify the appropriate conditions claimed by the applicant.

In re Rice, 178 USPQ 478 (CCPA 1973) also spoke to the issue of obviousness and whether proper directed was given to select a particular set of conditions stated that, "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *Id.* at 480. Moreover, to be able to pick and choose among the various permutations of Chiu's invention also requires that one of ordinary skill in the art would have found this to be obvious at the time the invention was made (i.e. as of 18 August 2000) and without benefit of the applicants' specification and claims before him (see MPEP 2142).

Since there is no factual basis to support that (1) the collection of ranges exists in the Chiu reference and/or (2) that if the collection of ranges existed or could exist through modification, that there was direction to make the appropriate selection and the applicants contest the rejection, the best possible outcome for the examiner is that there is equipoise between the examiner's and the applicants' position.

However, MPEP 2142 also states that to establish a *prima facie* case of obviousness, "The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to the rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e. the reference teachings establish a *prima facie* case of obviousness) is more probable than not." At this point, use of Chiu does not meet the more probable than not standard for establishing a *prima facie* case of obviousness.

As a side note, it is presumed that the examiner is aware of the latest *Festo* decision. While the applicants do appreciate the acknowledgement of claims 13-18 being allowable, the ramification of *Festo* is that virtually all amendments will be considered grounds for estoppel and applicants' representative cannot in good conscience amend claims if there is believed to be no factual support for the rejection. As a reminder as to why this is so, the following select passages from *Festo* are reproduced:

"...we reinstate those holdings of *Festo VI* that were not disturbed by the Supreme Court. To begin with, we recognize that the Court expressly endorsed our [Federal Circuit's] holding that a **narrowing amendment** made to comply with any provision of the Patent Act, **including §112, may invoke an estoppel....When the prosecution history reveals no reason for the narrowing amendment, Warner-Jenkinson presumes that the patentee had a substantial reason relating to patentability**; consequently, the patentee must show that the reason for the amendment was not one relating to patentability if it is to rebut that presumption....In this regard, we reinstate our earlier holding that a patentee's rebuttal of the **Warner-Jenkinson presumption is restricted to the evidence in the prosecution record.**" see *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, No. 95-1066 (Fed. Cir. Sept. 26, 2003), available at <http://www.fedcir.gov/opinions/95-1066c.doc>)

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 14 November 2003

By: Agata Glinzka
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